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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,696	11/20/2001	Joel B. Shamitoff		9731

7590
JOEL SHAMITOFF
5465 ASPEN STREET
DUBLIN, CA 94568

EXAMINER

MILLER, BENA B

ART UNIT PAPER NUMBER

3712

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,696

Applicant(s)

SHAMITOFF, JOEL B. *ch*

Examiner

Bena Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 is/are allowed.
- 6) ☒ Claim(s) 3,4,6-9,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 5 and 10-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11 and 1. 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the female-to-female connector must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the female-to-female as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. On page 13, lines 12-15, the specification discloses the female-to-female connector allowing appendages to be attached to each other and a male-to-male connector provided so that a torso of two or more toys can be affixed. However, the specification fails to describe how the female-to-female connector connects a female portion of a first snapable element to a female portion of a second snapable element and how the male-to-male connector connects a male portion of a snapable element to a male portion of a second snapable element as required in the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-20, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the number of snapable elements encompassed is not clear. Line 2 of claim 3 appears to require more than one snapable element; therefore, it is presumed that what is encompassed is more than one snapable element. However, lines 2-12 of claim 3 require that the snapable elements include the possibility of one and only one of a torso, leg, arm, etc. Said differently, claim 3, lines 1-12 appears to require more than one snapable element as well as include the possibility of one and

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only one snapable element. Continuing on with the claim, line 13 requires one or more snap portions affixed to at least two of the snapable elements. This portion of the claim is consistent with the interpretation whereby the claim encompasses more than one snapable element.

Regarding claim 6, it is unclear how the male-to-male connector connects a male portion of a snapable element to a male portion of a second snapable element as required in the claim.

Regarding claim 7, it is unclear as to how the female-to-female connector connects a female portion of a first snapable element to a female portion of a second snapable element as required in the claim.

Regarding claim 8, there is lack of proper antecedent basis for the limitations "said snap portion". It is unclear which snap portion of the previously claimed one or more snapable portions the claim is referring to.

Regarding claim 22, there is lack of antecedent basis for the claimed limitations "said first snap portion" and "said second and third snap portions".

Claim 23, in lines 2 and 3 of the claim, requires the possibility of a male snap portion only, a female snap portion only and a male and female snap portion. It appears that lines 7-31 is inconsistent with lines 2 and 3 if the snapable element only includes the male portion, as well as lines 4-6 and 10-31 being inconsistent with lines 2 and 3 if the snapable element only includes the female portion.

Lines 13-30 of claim 23 are vague and indefinite because that portion of the claim appears to recite a range within a range. Line 13 requires a variety of different

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looking toys including toys having an appearance of those listed in lines 15-30. It is not clear what toys are encompassed in the variety of different looking toys which are not included in the listed toys of lines 15-30.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Alger.

The claim as written does not require a male and female snap portion. Based on the language in the claim, it is interpreted as requiring that each of the snapable elements have a male snap portion only, a female snap portion only or male and female snap portions. The claim reads on Alger as having snapable elements 14 and 30 each including respectively a male snap portion (16,32). Alger appears to show lugs 16 being a different size than peg 32. The snap portions are capable of forming a human figure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millard in view of Ogsbury.

Millard teaches in the figures a toy comprising snapable elements including at least one of one or more arms (4), one or more snap portions affixed to the snapable elements (fig. 1 and 6), the snap portions including at least one of a male portion and female portion (fig. 6), the male portion capable of rotating with respect to the female portion (col. 2, par. 3), a female to female connector (fig. 7, 11) as recited in claim 7 and male-to-male connector (fig. 7, 11) as recited in claim 6. However, Millard fails to teach the first snapable capable of mating with and detaching from the female portion with an audible sound. Ogsbury teaches in col. 1, par. 5 toy constructions set having end spherical shaped end portions 13 that are interconnected with a common hub 14, so when portions 13 interlock with hub 14 an audible sound will be produced. It would have been obvious to one having ordinary skill in the art at the time the invention was made to produce a sound as taught by Ogsbury with the male and female snap portions of Millard for the purpose of pleasing the user and indicating the snap portions are firmly interlocked in place (col. 6, lines 5-8).

Claims 3, 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alger in view of Ogsbury.

Alger teaches in the figures most of the elements of the claimed invention, including snapable elements including at least one of one or more arms (14), one or more snap portions affixed to the snapable elements (16), the snap portions including at

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least one of a male portion and female portion (fig. 5) and at least one of hair (36) as recited in claim 8. However, Alger fails to teach the first snapable capable of mating with and detaching from the female portion with an audible sound. Ogsbury teaches in col. 1, par. 5 toy constructions set having end spherical shaped end portions 13 that are interconnected with a common hub 14, so when portions 13 interlock with hub 14 an audible sound will be produced. It would have been obvious to one having ordinary skill in the art at the time the invention was made to produce a sound as taught by Ogsbury with the male and female snap portions of Alger for of pleasing the user and indicating the snap portions are firmly interlocked in place (col. 6, lines 5-8).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Millard in view of Ogsbury as applied to claim 3 above, and further in view of Goodwin.

Millard and Ogsbury teach in the figures the claimed invention except for the snapable elements formed of plush material. Goodwin teaches plush toy having a male member that fits into mating alignment with recesses provided on the body (Abstract, lines 1-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate plush as taught by Goodwin to the snapable elements of Millard and Ogsbury for the purpose of pleasing the user and indicating the snap portions are firmly interlocked in place (col. 6, lines 5-8).

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Allowable Subject Matter

Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 5 and 10-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 24 is allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

The remarks in the RCE filed 07/24/03 are duly noted.


Bena Miller
Examiner
Art Unit 3712

bbm
September 17, 2003